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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* THOMAS F. BERGERT
9

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11 Appeal 2008-4902
12 Application 09/473,136
13 Technology Center 3600
14

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16 Decided:¹ May 8, 2009
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19 *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI and BIBHU
20 R. MOHANTY, *Administrative Patent Judges*.

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22 CRAWFORD, *Administrative Patent Judge*.
23

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25 DECISION ON APPEAL

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27 STATEMENT OF THE CASE

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-9, 11 and 13-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented systems and methods for making on-line reservations for recreational outings (Specification 1).

Claim 1, reproduced below, is further illustrative of the claimed subject matter:

1. A method of arranging a recreational outing for participants using a computer, comprising the steps of
 - a) providing a database of information including reservation information, said reservation information including at least one selection option, said option including a time and a date for an activity from a plurality of recreational facilities, said database further including profile information for a plurality of said participants, said profile information for each of said plurality of participants including at least one element;
 - b) receiving a non-facility specific request pertaining to a plurality of facilities for at least one selection option;
 - c) retrieving and transmit, based on said received request, at least one selection option pertaining to at least one available reservation;
 - d) receiving a selection from a first one of said participants of a selection option;
 - e) receiving indication information including a selection from said first participant of at least one element corresponding to an element of said profile information of at least one additional participant;
 - f) determining a subset of said participants from said database of participants having said profile element;

- g) communicating said selection to said subset of participants;
- h) receiving acceptance information from at least one other participant using a client computer and
- i) after receiving said acceptance information in step h), receiving instructions from said first participant using a client computer to book a reservation for the time and date and facility connected with said selection option.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Davies	US 5,596,636	Jan. 21, 1997
Henneuse	US 5,963,913	Oct. 5, 1999
Zhang	US 6,016,478	Jan. 18, 2000
Durand	US 6,272,467 B1	Aug. 7, 2001

Michael L. Kasavana, *Making more hours in the day*, 72 Club Management, 79 (1993) (hereinafter "Kasavana");

Christina Valdez Diaz, *Road Warriors plot their course early*, USA Today, Sep. 23, 1997 at E, 4:1 (hereinafter "Diaz").

James Romanesko, *Teemaster Speeds Booking Tee Times*, Saint Paul Pioneer Press, Mar. 16, 1998 (hereinafter "Teemaster");

Golf Agent, Your Internet Link, Golf Club Bookings via the Internet, <http://web.archive.org/web/19970331023023/www.golfagent.com/cgi-win/ClubSearch.exe> (last visited May 22, 2003) (hereinafter "GolfAgent");

The Examiner rejected claims 1-3, 5, 9, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Durand, Teemaster and Henneuse; rejected claims 14 and 16 under 35 U.S.C. § 103(a) as being

unpatentable over Davies in view of Durand, Teemaster, Henneuse and Zhang; rejected claims 17 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of GolfAgent, Teemaster, Henneuse and Kasavana; rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of GolfAgent, Teemaster, Henneuse and Zhang; rejected claims 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over GolfAgent in view of Davies, Teemaster and Henneuse; rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Durand, Teemaster, Henneuse, and Kasavana; rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Durand, Teemaster, Henneuse and Diaz; rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Durand, Teemaster, Henneuse, Diaz and Official Notice; rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Durand, Teemaster, Henneuse and Kasavana; and rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Zhang, GolfAgent, Teemaster, Henneuse and Kasavana.

We REVERSE.

ISSUES

Did the Appellant show the Examiner erred in finding that the reservation request and confirmation system of Davies discloses receiving a selection from a first one of said participants of a selection option, as recited in independent claim 1, where independent claim 1 also recites receiving

1 instructions from said first participant using a client computer to book a
2 reservation for the time and date and facility connected with said selection
3 option?

4 Did the Appellant show the Examiner erred in asserting that the event
5 scheduling system of Henneuse discloses providing access to a database of
6 information including reservation information including at least one
7 selection option including a number of openings available for one or more
8 additional individuals to join an activity, and receiving indication
9 information from the first participant including information necessary to
10 notify a number of individuals of said selection, the number of individuals
11 being greater than the number of available openings as recited in
12 independent claims 17, 18 and 21?

13 14 FINDINGS OF FACT

15 *Specification*

16 Appellant invented systems and methods for making on-line
17 reservations for recreational outings (Specification 1).

18 The recreational activity may be golf and the number of available
19 slots is limited by the number of golfers in the reservation (Specification 10).

20 21 *Davies*

22 Davies discloses an automated golf reservation system 17 including a
23 golf course host computer data base 16 (col. 2, ll. 39-44; col. 3, ll. 37-39).

24 A user enters desired primary and alternate reservation information
25 into Teephone unit 10. Teephone unit 10 then dials into system 17 with
26 primary desired reservation information, including time and date, and

several alternate options in case the primary desired reservation information is not available (col. 3, ll. 37-41; col. 4, ll. 26-35).

The system 17 then sends confirmation information to Teephone unit 10 if one of the desired reservation information is accepted (col. 4, ll. 35-37).

Henneuse

Henneuse discloses systems and methods for scheduling an event subject to the availability of requested participants using server application 16. Server application 16 receives event information from the scheduler in step 20 (col. 3, ll. 9-14).

Server application 16 then sends an electronic mail message to each requested participant where each message includes a link to the event reply page. The reply page may include the name of the scheduler, the name of the event, and one or more options defined by the scheduler, such as one or more potential schedules for the event (col. 3, ll. 30-51).

PRINCIPLES OF LAW

Claim Construction

Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. *See Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (stating that “not every process claim is limited to the performance of its steps in the order written”). However, such a result can ensue when the method steps implicitly require that they be performed in the order written. *See Loral*, 181 F.3d at 1322, 50 USPQ2d at 1870 (stating that “the language of the claim, the specification and the prosecution history support a

limiting construction[, in which the steps must be performed in the order written,] in this case”); *Mantech*, 152 F.3d at 1376, 47 USPQ2d at 1739 (holding that “the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise”).

Interactive Gift Express, Inc. v. CompuServe Inc., 256 F.3d 1323, 1342-43 (Fed. Cir. 2001).

The context of the surrounding words of the claim must be considered in determining the ordinary and customary meaning of those terms. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003).

Two distinct claim elements should each be given full effect. *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991).

Claim language cannot be mere surplusage. An express limitation cannot be read out of the claim. *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993).

“[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406

(2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

Selection Option

We are persuaded of error on the part of the Examiner by Appellant’s argument that the reservation request and confirmation system of Davies does not disclose receiving a selection from a first one of said participants of a selection option, as recited in independent claim 1 (Appeal Brief 7-8, 11; Reply Brief 3-4). Davies discloses that Teephone unit 10 interacts with automated golf reservation system 17 to make and confirm a reservation. The Examiner asserts that this corresponds to receiving a selection from a first one of said participants of a selection option as recited in independent claim 1 (Examiner’s Answer 5-6, 24-25).²

Independent claim 1, however, also requires receiving instructions from said first participant using a client computer to book a reservation for

² The user’s interaction with Teephone unit 10, prior to its interaction with system 17, cannot correspond to the receiving a selection step, as other portions of the claim, also cited as being disclosed by Davies, recite that the selection option is from the database (i.e., system 17). The user cannot “select” a selection option before the selection option has been provided to Teephone unit 10 from system 17. See *ACTV, Inc.*, 346 F.3d at 1088; *Interactive Gift Express, Inc.*, 256 F.3d at 1342-43.

1 the time and date and facility connected with said selection option. As claim
2 terms should be construed in the context of other claim terms, the receiving
3 a selection step must be construed in view of the receiving instructions step.
4 *See ACTV, Inc.*, 346 F.3d at 1088.

5 Under the Examiner's construction, both the receiving a selection step
6 and the receiving instructions step would book a reservation, the receiving a
7 selection step because the corresponding portion of Davies books a
8 reservation, and the receiving instructions step because the rest of the step
9 explicitly recites booking a reservation. There are two possible claim
10 interpretation paths that may be taken to resolve this quandary, however,
11 neither are allowed in a proper claim construction.

12 The first path involves collapsing both receiving steps into a single
13 step, i.e., *both* receiving steps would be fulfilled by the cited portions of
14 Davies. However, two distinct claim elements should each be given full
15 effect. *Unique Concepts, Inc.*, 939 F.2d at 1563. This is especially true
16 where the receiving a selection step must occur *before* the receiving
17 instructions step, because the receiving instructions step is dependent on a
18 response flowing from the receiving a selection step. *See Interactive Gift*
19 *Express, Inc.*, 256 F.3d at 1342-43.

20 As Davies has been cited as only corresponding to the receiving a
21 selection step, another reference must be cited as corresponding to the
22 receiving instructions step. However, the reservation has *already been*
23 *booked* in the receiving a selection step of Davies. One of ordinary skill in
24 the art would not have a reason to combine the cited portions of Davies with
25 another reference to apparently *rebook the same reservation*, this time under

1 the receiving instructions step, as would be required under the current
2 interpretation of these steps in independent claim 1.

3 The second path involves eliminating one of the receiving steps since
4 only one reservation is booked. The cited portions of Davies would then
5 correspond to the one and only receiving step that includes booking the one
6 and only reservation. However, claim language cannot be mere surplusage,
7 as an express limitation cannot be read out of the claim. *Texas Instruments*
8 *Inc.*, 988 F.2d at 1171. Accordingly, eliminating one of the receiving steps
9 of independent claim 1 is not a permissible option.

10
11 *Number of Openings*

12 We are also persuaded of error on the part of the Examiner by
13 Appellant's argument that the event scheduling system of Henneuse does not
14 disclose reservation information including a number of openings available
15 for one or more additional individuals to join an activity, the number of
16 individuals being greater than the number of available openings, as recited in
17 independent claims 17, 18 and 21 (Appeal Brief 9, 11; Reply Brief 4-7).

18 The Examiner asserts that Henneuse discloses the number of openings
19 because by inviting people, the event inherently has one or more openings
20 (Examiner's Answer 28-29). The Examiner may be correct if the claim
21 merely recited *at least one* opening. However, the claims recite that the
22 reservation information includes *the number* of openings, which requires an
23 actual number, especially in view of the later recitations in the claims that
24 the number of individuals is greater than the number of available openings.
25 *See ACTV, Inc.*, 346 F.3d at 1088. This interpretation is confirmed by the
26 Specification, where the number of openings is used in the context of a

1 limited number of slots in a golf reservation. *See Vitronics Corp.*, 90 F.3d at
2 1582. Henneuse does not disclose that an actual number of openings is
3 provided on the reply page.

4 The Examiner also asserts that Henneuse discloses that the number of
5 individuals is greater than the number of available openings because less
6 than all of the requested participants have accepted the event invitation
7 (Examiner's Answer 28-29). However, because the cited portions do not
8 disclose space restrictions, the most reasonable interpretation of Henneuse is
9 that should an invited individual desire to attend the event at a certain time,
10 an opening is available for them. The fact that they cannot attend does not
11 mean that the opening is not available. It merely means they will not attend.
12 If anything, the fact that only a *subset* of invited individuals will show up to
13 an event at a certain time, when every indication is that they could *all* be
14 accommodated, shows that there are *more* available openings than number
15 of individuals. Accordingly, Henneuse discloses that the number of
16 individuals is *less than or equal to* the number of available openings, and not
17 *greater than* as required by independent claims 17, 18 and 21.

18
19 *Other Claims*

20 As the rejections of independent claims 1, 17, 18 and 21 have been
21 reversed, the rejections of dependent claims 2-9, 11, 13-16, 19, 20, 22 and
22 23 are also reversed.

CONCLUSION

The Appellant has shown that the Examiner erred in rejecting claims 1-9, 11 and 13-23.

REVERSED

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